REMARKS

The allowable subject matter recited in claim 15 has been incorporated verbatim into base claim 14. No other amendments, cancellations, or additions have been made to the claims. As such, the present amendment does not introduce new matter or warrant a new search. Claims 1-14 and 16-30 remain pending in the case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Allowable Subject Matter

Applicant appreciates the Examiner's allowance of claims 9-13, 17-22 and 28-30 and awaits formal allowance of the remaining claims. Claims 2, 7, 8, and 15 were objected to as being dependent upon rejected base claims 1 and 14, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. As set forth below, all limitations of claim 15 have been incorporated into base claim 14. Accordingly, Applicants assert that independent claim 14, and all claims dependent therefrom, are now in condition for allowance. Arguments are provided below as to the patentability of independent claims 1 and 23, as well as all dependent claims therefrom.

Section 102 Rejections

Claims 14 and 16 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,446,256 to Hyman et al. (hereinafter "Hyman"). As noted above, independent claim 14 has been amended to include subject matter deemed in the Office Action as allowable. Applicants agree that Hyman does not teach the various features set out in amended independent claim 14. No amendments were made to the claims which would warrant further examination since a previously examined dependent claim was inserted into the present independent claim -- the dependent claim noted as being allowable in the Office Action. Accordingly, removal of the § 102(e) rejection of claims 14 and 16 is respectfully requested.

Section 103 Rejections

Claims 1, 3-6 and 23-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hyman. In order to sustain the Examiner's burden of showing a *prima facie* obviousness of a claimed invention, three essential criteria must be met. First, there must be some suggestion or motivation, either in the cited reference or in the knowledge generally available to one of ordinary skill in the art. Second, there must be a reasonable expectation of success. As stated in MPEP 2143.01, the fact that references can be hypothetically combined or modified is not sufficient to establish a *prima facie* case of obviousness. *See In re Mills*, 916 F.2d. 680 (Fed Cir. 1990). Finally, the prior art references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d. 981 (CCPA 1974); MPEP 2143.03, emphasis added. Specifically, "all words in a claim must be considered when judging the patentability of that claim against the prior art." *In re Wilson* 424 F.2d. 1382 (CCPA 1970). Using these standards, Applicant asserts that the cited art fails to teach or suggest all features of the currently pending claims, and furthermore, cannot be modified to do so. Some distinctive features of the present claims are set forth below.

Hyman fails to teach, suggest or provide motivation for a transcoder proxy (claim 1) or method (claim 23) for transcoding an electronic document, where the method includes receiving the electronic document in a first digital format, forming a model of a logical structure of the electronic document, and using the model to produce a script, which includes at least a portion of the document expressed in a second digital format. Independent claim 23 recites, in part:

> A method for transcoding an electronic document having at least one element, comprising: receiving the electronic document in a first digital format, wherein the document includes an element [which] includes JAVASCRIPT code... forming a model of a logical structure of the electronic document, wherein the model includes the element and [a unique] identifier assigned to the element ... using the model to produce a script, wherein the script includes at least a portion of the document expressed in a second digital format, and wherein the script includes the element and the identifier assigned to the element ...

Independent claim 1 (a system claim) recites a similar limitation.

In conventional electronic document delivery systems, resource limitations of a client machine (e.g., limited memory, processing and/or display capabilities) may not allow the client machine to support interactive aspects of electronic documents, such as Web pages. When an electronic document is provided to a client machine with resource limitations, any computer language code or script within select portions (e.g., interactive portions) of the document may be removed. These interactive portions may include, e.g., hypertext links and JAVASCRIPT events. As a result, web site navigation capability may be lost, and with

it the ability to access Web site information. In some cases, a client machine may not have sufficient resources to provide an assistive technology solution for a physically challenged user. *See*, e.g., Specification, page 4, lines 6-13.

To overcome limitations of the prior art, the present Specification provides an electronic document delivery system which allows a client machine (with limited resources) to provide interactive aspects of electronic documents, such as Web pages, and/or assistive technology solutions for a physically challenged user. *See*, e.g., Specification, page 4, lines 15-18.

According to one embodiment, a method (claim 23) for transcoding an electronic document, which may be embodied within a transcoder proxy (claim 1), includes receiving the electronic document in a first digital format (e.g., HTML, XML, POSTSCRIPT, PDF, AFP, etc.) and assigning unique identifiers to the elements (e.g., paragraphs, hypertext links, lists, tables, images, etc.) within the electronic document. A model of a logical structure of the electronic document is formed, including the elements and identifiers assigned thereto. The model may also define methods for accessing and manipulating the document. The model may be, for example, a tree-like document object model (DOM). The model may then be used to produce a script, including at least a portion of the document expressed in a second digital format (e.g., a scripting language understood by the client machine). The script includes the elements and the identifiers assigned to the elements. Once the script is provided to the client machine, the client machine may ultimately use the script to issue output commands to, e.g., an output device with limited display capabilities and/or assistive technology capabilities. *See*, e.g., Specification, page 8, lines 13-23; page 11, line 3 to page 13, line 8.

Unlike the presently claimed case, Hyman fails to provide teaching or suggestion for a transcoder proxy (claim 1) or method (claim 23) for transcoding an electronic document, where the method includes receiving the electronic document in a first digital format, forming a model of a logical structure of the electronic document, and using the model to produce a script, which includes at least a portion of the document expressed in a second digital format.

Instead, Hyman discloses "a technique whereby parsable structures (such as XML trees or structures created in other languages) can be extended to include external objects providing additional functionality." (Hyman, column 3, lines 24-27). For example, Hyman discloses that an object interface (200, Fig. 2) and/or a language interface (300, Fig. 3) may be used to extend the functionality of a

particular computer programming language (e.g., XML). The object interface of Hyman may extend the capability of a particular computer language by allowing an external object (i.e., a user-created computer-executable) to interact with a parsable structure (e.g., an XML tree). The language interface of Hyman may extend the capability of a particular computer language through the addition of a customized keyword (such as "FredWhile", as shown in Tables 1 and 2 of Hyman). *See*, e.g., Hyman, column 2, lines 7-67; column 5, lines 62-66; and column 6, lines 7-52.

Figs. 4-5 of Hyman illustrate how a parsable structure (such as an XML tree) may be extended to include one or more additional external objects (410, 414) through the use of an object interface (411, 415). For example, Hyman discloses that an XML parser may read through an XML document to create an internal data structure (i.e., an XML DOM tree, as shown in Fig. 4). Whenever the XML parser encounters an element constituting a new external object (507, Fig. 5), it may create a new node in the XML tree (e.g., nodes 410 and 414, Fig. 4) if the object interface associated with the object possesses the necessary interface (505, Fig. 5) that will allow it to interoperate with the XML tree.

In other words, Hyman discloses a technique for adding new executables (via an object interface) and/or new custom keywords (via a language interface) to a particular computer programming language. Hyman does not, however, teach or suggest a method for transcoding an electronic document, where the electronic document is actually "transcoded" or "translated" from a first digital format (e.g., HTML, XML, POSTSCRIPT, PDF, AFP, etc.) into a second digital format (e.g., a scripting language understood by a client machine), as set forth in present claims 1 and 23. In other words, the logical model (i.e., the XML tree) of Hyman is not used to produce a script, which includes at least a portion of the document expressed a second digital format. Instead, the logical model of Hyman is merely extended by adding new executables (via an object interface) and/or new custom keywords (via a language interface) to the particular computer programming language. One skilled in the art would easily understand how extending a particular computer programming language, as taught by Hyman, is altogether different from translating an electronic document from one digital format (or language) to another, as taught by the presently claimed case.

In addition to lack of teaching, Hyman cannot be modified to disclose the aforementioned claim limitations, since doing so would render the modified invention of Hyman unsatisfactory for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for

its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As noted above, the intended purpose of Hyman is to provide a technique whereby parsable structures (such as XML trees or structures created in other languages) can be extended to include additional external objects, thus providing a particular computer programming language with additional functionality/capability. For example, the invention of Hyman "provides a means by which external objects can interact with a language engine ... so as to implement new keywords and new functionality previously unanticipated." *See*, e.g., Hyman, column 3, lines 24-27, and column 3, line 63 to column 4, line 11. However, if the invention of Hyman were modified to, instead, translate an electronic document from one digital format (or language) to another, the invention of Hyman would be unable to extend the functionality/capabilities of a <u>particular</u> computer programming language, thus rendering the modified invention of Hyman unsatisfactory for its intended purpose.
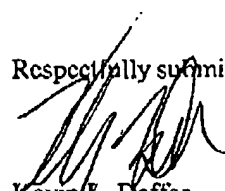
For at least the reasons set forth above, Hyman simply fails to teach or suggest, and cannot be modified to teach or suggest, all limitations of claims 1 and 23. Therefore, claims 1 and 23, as well as claims dependent therefrom, are asserted to be patentably distinct over the cited art. Accordingly, removal of the § 103(a) rejection of claims 1, 3-6, and 23-27 is respectfully requested.

CONCLUSION

This response constitutes a complete response to the issues raised in the Office Action mailed March 9, 2005. In view of the remarks traversing the rejections, Applicants assert that pending claims 1-14 and 16-30 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to deposit account number 09-0447.

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